

Appl. No.: 09/328,742  
Response to Office communication dated: 2/22/2006  
Attorney Docket: UCONAP/141/US

### **REMARKS**

There are no additions, cancellations or amendment to the claims or specification. Claims 23-25 and 27-28 are pending in the application.

#### **The rejection of claims 23-25 and 27-28 under 35 U.S.C. §102.**

The Office communication rejected claims 23-25 and 27-28 as allegedly being anticipated by the publication: Beltramo M., Stella N., Calignano A., Lin S. Y., Makriyannis A., Piomelli D; "Functional Role Of High-Affinity Anandamide Transport, as Revealed By Selective Inhibition"; Science; vol. 277; 1094-1097; 1997; or as allegedly being anticipated by the publication: Calignano A., La Rana G., Beltramo, M., Makriyannis A., Piomelli D; "Potentiation of Anandamide Hypotension by the Transport Inhibitor, AM404"; Eur. J. Pharmacol.; 1997; 337 R1-R2.

More particularly, the Office communication asserts only that the use of N-(4-hydroxyphenyl)arachidonylamide (compound AM404) to inhibit transport of anandamide in cells is disclosed in both of these applications.

The earliest referenced date in these publications appears to be August 21, 1997.

- **Applicant's 09/328,742 application properly claims priority from a U.S. Provisional Patent Application**

Applicant's 09/328,742 application was filed on June 9, 1999. The '742 application properly claims priority from U.S. Provisional Patent Application No. 60/088,568, filed on June 9, 1998. The priority claim can be found in page 1 of the as filed specification and in the as filed Inventors' Declaration.

- **The MPEP states that the effective filing date of an application claiming benefit under 35 USC §119(e) to a provisional application is the filing date of the provisional application.**

MPEP §706.02(V)(D)<sup>1</sup> states that the effective filing date of an application claiming benefit under 35 USC §119(e) to a provisional application is the filing date of the provisional application for any claims which are supported by that provisional application.

- **U.S. Provisional Patent Application No. 60/088,568 supports the use of N-(4-hydroxyphenyl)arachidonylamide (compound AM404).**

U.S. Provisional Patent Application No. 60/088,568 (copy enclosed) discloses the structure of compound AM404 and its use as an anandamide transport inhibitor. The '568 application also provides guidance on where to find synthesis information for compound AM404 at page 9 of the '568 application (page 6 of the Science article preprint referencing footnote 19).

- **The publications cited in the 2/22/2006 Office communication are NOT prior art under 35 USC §102(b).**

The present '742 application properly claims priority from the '568 provisional application filed on June 9, 1998. The '568 provisional application supports the use of compound AM404 as an anandamide transport inhibitor. The proper effective filing date for the '742 application is June 9, 1998. The proper 102(b) bar date for the '742 application is June 9, 1997.

The earliest publication date for the publications cited in the 2/22/2006 Office communication appears to be August 21, 1997. The publications cited in the 2/22/2006 Office communication are NOT 35 USC §102(b) prior art. At best, the publications cited in the 2/22/2006 Office communication may be prior art under 35 USC §102(a).

---

<sup>1</sup> MPEP, Rev. 3, August 2005, page 700-23

Appl. No.: 09/328,742  
Response to Office communication dated: 2/22/2006  
Attorney Docket: UCONAP/141/US

- **A 35 USC §102(a) reference may be overcome by submission of a declaration under 37 CFR §1.131.**

MPEP §706.02(b)<sup>2</sup> states that a rejection under 35 USC §102(a) can be overcome by filing an affidavit or declaration under 37 CFR 1.131 showing prior invention.

Enclosed herewith is a DECLARATION OF ALEXANDROS MAKRIYANNIS UNDER 37 C.F.R. 1.131 and Exhibits A to E. The Declaration and Exhibits establish completion of the presently claimed invention by the inventors in the United States before August 1, 1997.

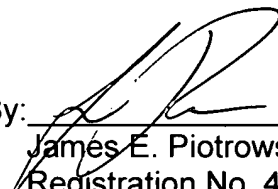
As attested to in the accompanying DECLARATION, the presently claimed invention predates the publication date of the publications cited in the 2/22/2006 Office communication, which are no longer proper prior art under 35 USC §102(a). Applicant's pending claims are patentable for at least this reason.

In summary, Applicants have addressed each of the rejections within the present Office Action. It is believed the application now stands in condition for allowance, and prompt favorable action thereon is respectfully solicited. The Examiner is invited to telephone Applicant's attorney if it is deemed that a telephone conversation will hasten prosecution of this application.

Respectfully submitted,

Alexandros MAKRIYANNIS et al

Date: 8-15-2006  
750 Main Street- Suite 1400  
Hartford, CT 06103-2721  
(860) 527-9211

By:   
James E. Piotrowski  
Registration No. 43,860  
Alix, Yale & Ristas, LLP  
Attorney for Applicants

G:\AYR saved docs\Filing Docs\Uconap\uconap141us\1105 response.doc

<sup>2</sup> MPEP, Rev. 3, August 2005, page 700-27